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I hereby certify that this complete correspondence regarding my Patent Application No. 09/896,680 is being deposited with the United States Postal Service as EXPRESS mail, article number EU245068241US with sufficient postage pre-paid in an envelope addressed to: Commissioner for Patents, PO BOX 1450, Alexandria VA 22313-1450, on this

date: January 30, 2004

Brad A. Armstrong, Inventor / Applicant

Commissioner for Patents  
PO BOX 1450  
Alexandria VA 22313-1450

### Responsive to the Outstanding Office Action Mailed 07/31/03

Re: Patent Application of Brad A. Armstrong

Serial No.: 09/896,680

Filed: 06/29/2001

Applicant's file no. F29

Correspondence mailing address: Brad A. Armstrong  
P.O. Box 1419  
Paradise, CA 95967

Title: CONTROLLER WITH ANALOG PRESSURE SENSOR(S)

Examiner: Enatsky, Aaron L.

GAU: 3713

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Sir:

### REMARKS

Please enter the herein Amendments, consider the Remarks, Interview Summaries and in view thereof, find the Application once again in condition for Allowance.

A Petition for Additional Time for responding by Applicant as well as the \$475.00 fee payment therefor are attached. Thank you.

The Office Action date mailed 07/31/2003 has been carefully reviewed.

It is noted that the previously allowed claims 1-47 are now rejected.

The rejection is made with the Withdrawal of Allowance and is made after the payment of the Issue fee.

Applicant has received from the Examiner two interview summaries. In the summary of the interview mailed 1/20/2004 pertaining to the Jan. 14, 2004 interview, the Examiner states:

"Examiner acknowledges that the art used in the rejection was in fact already of record and the statement of newly discovered references was in error."

Then the Examiner went on to give new reasoning, stating:

"The status of the withdrawal is that prior art not previously applied in a rejection was in fact properly used in a rejection on 7/31/03 and claims remain rejected."

### **QUESTION # 1**

**Applicant requests to know under what law, rule or precedent the above reasoning is made?**

**QUESTION # 2**

**Is such reasoning supported by MPEP 706.04, or the court precedents sited therein?**

**QUESTION # 3**

**Applicant respectfully would like to know why the Examiners are not following the Patent Office rule MPEP 706.04?**

**QUESTION # 4**

**Applicant respectfully would like to know what MPEP rule allows a disregard for the specific requirements and case law set forth in MPEP 706.04?**

**QUESTION # 5 A and B**

**Do the Examiners believe in practicing the “Great care” legal standard of MPEP 706.04? Would the Examiners please inform Applicant what they believe “Great care” means. How does using “Great care” square with asserting “newly discovered references” that are NOT newly discovered?**

**QUESTION # 6**

**Do the Examiners believe in practicing the “clear error” legal standard of MPEP 706.04?**

**QUESTION # 7**

**If the Examiners assert that the Previous Examiner made a “clear error” then on what grounds do the Examiners assert that a higher court certainly would find unquestionable error?**

Applicant believes the only “**clear error**” in this file is what has been done **after** the claims were allowed and **after** the issue fee was paid. The written grounds for withdrawal have been **now admitted** by the current Examiner to be **in error**. The current Examiners, T. Walberg, M. O'Neill, and A. Enatsky seem determined to proceed with what appears to Applicant as **arbitrary and capricious decisions** without stated basis in rule or law or court precedent.

Applicant is being harmed by the Examiners’ arbitrary and capricious decisions.

In light of the great disparity of power between Examiners and Applicants (i.e. Examiners have all the power and Applicants none), Applicant proceeds against his will, under protest and threat of having his allowed patent application go abandoned, in again guiding his claims through the 35 USC 102 and 35 USC 103 tests.

Two Interview Summaries are attached and form a portion, for further consideration, of this response to the Office Action of 7/31/03.

**The Interview Summary of the Jan. 7, 2004 Interview:**

A telephone interview occurred on Jan. 7, 2004 between Applicant Pro Se Brad A. Armstrong and Patent Examiner Aaron Enatsky. The interview lasted approximately 30 minutes from 3 PM to 3:30 PM Eastern Time and dealt with a discussion of the proper procedure according to the Courts and the Patent Office MPEP for "Rejection of Previously Allowed Claims".

The subject of the interview was as follows:

Applicant first directed the Examiner to MPEP 706.04 "Rejection of Previously Allowed Claims" where Applicant and the Examiner read together the second sentence "**Great care should be exercised in authorizing such a rejection.** See *Ex Parte Grier, 1923 C.D. 27, 309 O.G. 223 (Comm'r Pat. 1923); Ex Parte Hay, 1909 C.D. 18, 139 O.G. 197 (Comm'r Pat. 1909)*". Applicant pointed out to the Examiner that this is a long standing precedent set forth by the Courts and honored by the Patent Office for now 95 years.

**First Issue:**

In the next paragraph of MPEP 706.04 Applicant and the Examiner read together the first sentence "**Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art.**" Thus, it appears to Applicant that the Patent Office can reject previously allowed claims for one of two reasons:

- 1) a clear error in the previous action, or
- 2) knowledge of other prior art.

Applicant directed the Examiner to the Office Action date mailed 07/31/2003 page 2 second paragraph where Applicant and the Examiner read together the sentence "**Prosecution on the merits of this application is reopened on claims 1-47 considered unpatentable for the reasons indicated below: Newly discovered references make the current claims unpatentable.**" Applicant asked the Examiner if this meant the "Newly discovered references" were new to the file and had not previously been considered by the previous Patent Examiner. The Examiner stated the affirmative.

Applicant directed the Examiner to the first rejection page 2 paragraph 4 wherein the Examiner relies on "Japanese Unexamined Utility Model Application Publication No 5-87760 to Furukawa". Applicant asked the Examiner if this is one of the "Newly discovered references" causing withdraw of the claims because this prior art had not been considered by the previous examiner? The Examiner answered in the affirmative.

Applicant directed the Examiner to the second rejection page 4 paragraph 3 wherein the Examiner relies on "Japanese Unexamined Patent Application

Publication No 7-302159. Applicant asked the Examiner if this is the second of the "Newly discovered references" causing withdraw of the claims because this prior art had not been considered by the previous examiner? The Examiner answered in the affirmative.

Finally, Applicant directed the Examiner to Applicant's Information Disclosure Statement dated 1-8-2002 sheet 10 signed at the bottom by previous Patent Examiner John Paradiso on 4/19/02. Applicant directed the Examiner to the section "Foreign Patent Documents" just above Examiner Paradiso's signature where the first two references, initialed by the Examiner, are 5-87760 and 7-302159.

Thus, the Patent Office and present Examiner have erred because the documents relied on for "Rejection of Previously Allowed Claims" as "Newly discovered references" were in fact already in the file and had been considered and overcome in the view of the previous Examiner.

#### **Second Issue:**

During the course of the interview the Examiner stated that he was examining this Application just like any other application that he is given. Consequently, Applicant directed the Examiner to MPEP 706.04 the second sentence of paragraph 3 where they read together: "**In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner...**".

Applicant expressed that the Patent Office had seriously, clearly erred in procedure in that no "newly discovered references" actually exist, and that the proper next step for the Patent Office should be to go back and actually use "**Great care**" as has been mandated by the Courts and the Commissioner for now ninety-five years (MPEP 706.04). The Patent Office should reassess this file, especially in light of the fact that **no "Newly discovered references"** actually exist.

The Examiner expressed concern that even though the Patent Office may have erred in the "Rejection of Previously Allowed Claims", nevertheless the Examiner has concerns about the claims allowability over the two Japanese references. The Examiner would like to have a telephone interview discussing the merits of the claims in light of the Japanese references. Applicant expressed that the claims have already been examined in view of the Japanese references and that to Reexamine Applicant's claims in view of the Japanese references is to hold Applicant's patent application to a higher standard than all other patent applications.

Even though Applicant believes his claims were properly allowed and are now being improperly reexamined he will submit to a telephone interview regarding the already examined Japanese references.

The next interview is scheduled for 3PM Jan. 14<sup>th</sup> 2004.

#### **End of Telephone Interview of January 7, 2004**

The next week a second interview was held as summarized below.

#### **The Interview Summary of the Jan. 14, 2004 Telephone Interview:**

A telephone interview occurred on Jan. 14, 2004 between Applicant Pro Se Brad A. Armstrong and Patent Examiners Aaron Enatsky, Teresa Walberg and Micheal O'Neill. The interview lasted approximately 50 minutes from 3:05 PM to 3:55 PM Eastern Time and dealt with a discussion of the proper procedure according to the Courts and the Patent Office MPEP 706.04 "Rejection of Previously Allowed Claims" and MPEP 1308.01 . Also dealt with was prior art reference Japanese document 5-87760 (Furukawa).

#### **Further Details:**

Applicant thanked the Examiners for taking the time from their busy schedules for this interview. Applicant explained that what he wanted was what he also thought the Examiners wanted: "That only allowable claims should issue into patents". Applicant also expressed the need to follow the law as set forth by the Congress and the Courts and the Rules of the Patent Office, otherwise actions taken by individuals in the Patent Office would "arbitrary and capricious". Applicant pointed out that MPEP 706.04 for "Rejection of Previously Allowed Claims" is the Patent Office Rule governing the current situation. It has been previously determined between Examiner Enatsky and Applicant that the Examiner's rejection date 7/31/03 was based on "newly discovered references" in error. It is agreed that the "references" are in fact not new but rather had been previously considered by the Previous Examiner.

Applicant pointed out that MPEP 706.04 states "Full faith and credit should be given to the search and action of the previous examiner unless there is clear error in the previous action or knowledge of other prior art". Since there is no other prior art Applicant asserted that the Patent Office should withdraw the outstanding Office Action and make a new assessment as to whether the previous Examiner had made a "clear error". Applicant stated that "clear error" is a long standing legal standard that in summary means "a higher Court would find unquestionable error" and that the appropriate action at this point is not to reconsider Applicant's claims in view of the prior art under the criteria of 35 USC

102 and 103 but rather the correct action should be to find whether the Previous Examiner had committed "clear error" when he examined the claims under the criteria of 35 USC 102 and 103 in view of the prior art. Examiner Walberg did not agree with Applicant and stated that they were proceeding to reexamine the claims under the criteria of 35 USC 102 and 103 again.

In order to set the Examiner's minds at ease and to reassure them of the correct allowability of the claims Applicant entered into a discussion of the claims in view of Furukawa 5-87760:

Applicant pointed the Examiners to specific elements of Applicant's claim 1, namely,

- a two hand-held game controller with
- a pressure-sensitive individual button, or
- a variable pressure sensor positioned in the right-hand area.

Applicant pointed out to the Examiner that in his 7/31/03 Office Action concerning claim 1 he did not acknowledge Applicant's individual button associated with a pressure-sensitive variable sensor, nor did the Examiner acknowledge the right-hand location of the pressure-sensitive sensor. Applicant offered to point the Examiners to the criticality of those features in his specification. Examiner Enatsky asked to review Furukawa.

Applicant reviewed Furukawa 5-87760 with the Examiners in some detail. Applicant directed the Examiner to Figs. 1, 2 and 3 of Furukawa and with the Examiners reviewed the written portion of page 2 lines 8-14 describing the figures. Applicant specifically directed the Examiners to the number 12 and the small triangle of Fig. 1 for later reference in the reading of the specification. Then Applicant pointed the Examiners to numbers 29, 30 and 33 of Fig. 2 which are numbers only associated with the invention. Applicant then directed the Examiners to page 6 of Furukawa line 3 where they read together the sentence beginning with "Fig. 1 illustrates...". Applicant pointed out that in this sentence cross key 12 is located in the "left portion of the controller" and that "reference numerals 19 and 20" are shown in the right hand portion of the controller. Applicant took care to emphasize to the Examiners that this "reference numerals 19 and 20" is the one and only reference to Furukawa's individual buttons in the entire written document.

Applicant explained that there are many explicit descriptions in the following text which describe that the pressure sensor of Furukawa is located in the cross key 12 in the left hand area of Furukawa's controller 10. Specifically, Applicant directed the Examiners to the next paragraph [0009] beginning with the sentence "Fig. 2 is a longitudinal sectional front view illustrating a rubber contact 29 of the cross key 12 ..." Applicant pointed out that rubber contact 29 is specific to Furukawa's pressure sensor and is explicitly located in the cross key 12 in the left hand area of Furukawa's controller, as a first example.

In the interest of written brevity of this summary, a second and similar explicit description was read and explained in the third sentence of paragraph [0009]. Applicant apologized for needing to repeatedly point out the repeated explicit structuring of Furukawa's pressure sensor in the four-way cross key 12 located in the left hand area.

As a third explicit example of the placement/use of Furukawa's pressure sensors Applicant directed the Examiners to page 7 first full paragraph [0010] first sentence wherein part 30 and 29, which are specific to Furukawa's pressure sensor are located at the triangle symbol portion of cross key 12. Examiner Enatsky said I think I can see where you are going with this. Applicant replied yes and there were several additional explicit and clear assertions of Furukawa placing his pressure sensor in the left hand located, two-axis co-dependent cross key 12.

Examiner Walberg said I think we should consider the second sentence of paragraph [0009] on page 6 where she read "Although in this embodiment the rubber contact of the cross key 12 is discussed, the present invention is not restricted to this." Applicant responded that all patent applications have such generic open-ended statements and that in this disclosure there is only one other embodiment of Furukawa's pressure sensor that is not in Furukawa's cross key 12. Applicant directed the Examiners to page 8 paragraph [0011] the second sentence where the Examiner's read along with Applicant "However, the switch of the present invention may be used for a resistor of a multi-vibrator so as to change the frequency by the pressing force of the switch." Applicant pointed out that all of Furukawa's pressure sensor embodiments are explicitly described associated with Furukawa's 4-way cross key 12, and the only other embodiment of the pressure sensor taught or suggested by Furukawa is to control a "multi-vibrator" which apparently has nothing to do with a controller of a video game. Applicant asserted that Furukawa did not invent or suggest a two hand held game controller having a pressure sensor located in the right hand area, or on a discrete or independent button. If Furukawa had, he would have so stated at least one time.

Examiner Enatsky stated that he needed to review Furukawa in greater depth now in view of his new understanding of Applicant's claimed elements.

Applicant asked how do we go forward from here? Examiner Walberg stated that Applicant should reply to the outstanding Office Action. Applicant reiterated that he believed that because the Office Action was issued on the grounds of "newly discovered references" which are now recognized to be NOT "newly discovered" that the Office Action should be properly withdrawn. Then the Application should be taken back to publishing and allowed to issue, or the Application should be examined with "Great care" to determine if the previous Examiner made a "clear error" in allowing the claims over the cited art as set forth in MPEP 706.04.

Examiner Walberg insisted that Applicant should reply in writing to the outstanding Office Action.

Applicant thanked the Examiners for their time.

**End of Telephone Interview of January 14, 2004.**